REMARKS

The following remarks are made in response to the Final Office Action mailed January 18, 2006. In that Office Action, the Examiner rejected claims 1, 3, 4, 7, 9, 12, 15, 16, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Publication NO. 2001/0009017 ("Biliris") in view of Jones, U.S. Patent Publication No. 2001/0046069 ("Jones"). Claims 5, 6, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 1 above, and further in view of Joseph et al., U.S. Patent No. 5,761,415 ("Joseph"). Claims 10 and 11 were rejected under e5 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and in view of Arnold, U.S. Patent No. 6,275,848 ("Arnold"). Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7, and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1, 3-7, 9-16, 18, 20, and 21. Claims 1, 3-7, 9-16, 18, 20, and 21 remain pending in the application and are presented for reconsideration and allowance.

Reply to Examiner's Response to Arguments

Independent claim 1 includes the limitations "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory" and "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company." With respect to claim 1, the Examiner acknowledged that Biliris fails to teach or suggest the above-quoted limitations of claim 1, but stated that Jones teaches these limitations. (Final Office Action at para. no. 4, page 8).

In the Response to Arguments section of the present Office Action, the Examiner stated the following:

> As stated earlier, Jones at para. [0017] teaches "The data fields and flags in a typical watermark payload are shown in FIG. 2. It should be understood that the fields and flags shown are merely representative and they

> can take may alternative forms. The first embodiment of the invention utilizes one of the flag fields to indicate that a particular document is confidential. The other fields can be used in a conventional manner. **Alternative embodiments can use a number of flags to indicate actions that should be taken with a particular message**.
>
> Further, at para. [0020] and [0021], Jones teaches "The system could merely check the sender against this list or **alternatively, the system could require that a password be entered when such messages are encountered**. The table above shows only three fag (sic) bits. A system could have more or less fag (sic) bits as the needs of the particular system require. [0021] The import (sic) point is that **the system considers the message sender, the message recipient and the condition of the flags** in the data carried by a digital watermark to determine **what action should be taken.**"
>
> Thus, Jones teaches "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed to at least one destination internal to the company." (Final Office Action at para. no. 2, page 3) (emphasis added in Office Action).

The Examiner's above-quoted remarks relate to the digital watermark disclosed in Jones, the flag bits that are included in the digital watermark, and the actions that are taken when a digital watermark is received by the email server 302. It is important to note that Jones discloses that the digital watermark is encoded into machine-readable form by, for example, line width modulation or pixel luminosity modulation. (See, e.g., Jones at para. nos. 0016, 0021, and 0022). Thus, since the digital watermark is not even in a human-readable form, the digital watermark itself, and the flag bits encoded therein, do not provide any indication to recipients regarding destinations of a network communication, and certainly do not "indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1.

There is also no teaching or suggestion in Jones that one of the actions to be taken when a digital watermark is received is to add an identifier to the network communication to indicate to recipients whether the network communication is directed only to destinations internal to a company. The disclosure cited above regarding the conventional procedure of a entering a password certainly provides no such teaching or suggestion. Thus, like Biliris, Jones also does not teach or suggest "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1.

In the Response to Arguments section of the present Office Action, the Examiner further stated that:

> Now, as part of "what action should be taken", Jones teaches at para. [0020] the following database:
>
> | Sender Group | Recipient Group | Flag Conditions | Action |
> |---|---|---|---|
> | S1 | R1 | 011 | Send message |
> | S1 | R2 | 110 | Do not sent message notify the administrator |
> | S1 | R2 | 001 | Send message, and log fact that S1 sent a message to R2 |
> | S1 | R2 | 101 | Return message to sender |
> | S2 | R1 | 011 | Send message |
> | S2 | R3 | 110 | Do not sent message and notify the system administrator |
>
> And further elaborating on the above database, Jones elucidates at para. [0020], "It should be clearly noted that the above is merely a simplified example of the rules and combinations that could be in data base 401. The databases could include hundreds or thousands of users and it could include dozens of rules. The system can be complex or simple as desired for a particular application. A system can include many alternatives in addition to those shown above or a system might include only a very few alternatives. For example, the system could include only a list of addresses which are authorized to receive messages which have a confidentiality flag set to "confidential". Such a system would allow confidential documents to be only sent to selected addresses."
>
> **The intent providing the proper context for the invention's implementation is clearly declared by Jones** as disclosed in para.[0003] and [0004], as being "[0003] The Internet presents security challenges to corporations and others who have computers which store confidential information and which have connections to the internet. Traditionally, documents containing confidential information are marked with a legend or other visual indicia with words such as "CONFIDENTIAL", "PROPRIETARY", etc. The presence of these marks alert anyone handling such documents that they should only be transferred outside of company under special precautions. It is relatively difficult and unusual for someone to inadvertently manually send such a document to an unauthorized receiver. However, the use of Internet communication changes the situation. [0004] The Internet and electronic mail speeds the communications process; however, the Internet and electronic mail also make it much easier to inadvertently or accidentally send a confidential document to an unauthorized receiver. A single accidental or inadvertent keystroke can have wide raging (sic)

> unintended consequences. The Internet and other electronic communication system make it easy to communicate; however, these systems and networks also makes it easy to mistakenly or inadvertently sent (sic) a document to the wrong party."
>
> Thus, Jones teaches "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory". (Final Office Action at para. no. 2, pages 3-5) (emphasis added in Office Action).

In the above block quote, the Examiner discussed the data base 401 disclosed in Jones. As shown above, there is nothing in the disclosure regarding the data base 401 that teaches or suggests comparing destination information in a network communication to information in a company directory of a directory server, or determining whether a network communication is directed to a destination that is internal to a company based on such a comparison.

The Examiner, therefore, relies on what the Examiner refers to as the "intent providing the proper context for the invention's implementation", citing paragraphs 0003 and 0004 of Jones. As shown above, there is nothing in the background disclosure regarding confidential information that teaches or suggests comparing destination information in a network communication to information in a company directory of a directory server, or determining whether a network communication is directed to a destination that is internal to a company based on such a comparison.

In addition, as indicated by Jones at para. no. 0003, the "confidential" or "proprietary" marking on a document is based on the content of the document (i.e., based on whether the document contains confidential information), as opposed to being based on destinations specified in a given communication. Jones at para. no. 0003 clearly indicates that confidential documents can be transferred outside of a company. This is in accord with the normal practice of most companies, which routinely send confidential information to destinations outside of the company, such as, for example, to attorneys, financial firms, and partner companies under non-disclosure agreements. Since confidential documents can be, and are, sent to destinations outside of a company, a confidential marking does not indicate to recipients that any given communication is directed only to destinations that are internal to a company. There is nothing in the above background disclosure regarding confidential information that teaches or suggests comparing destination information in a network communication to information in a company directory of a directory server, determining whether a network communication is directed to a destination that is internal to a company based on such a comparison, or adding an identifier to a network communication to indicate to recipients whether the network communication is directed only to destinations internal to a company.

The Examiner's specific rejections are addressed in further detail below.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1, 3, 4, 7, 9, 12, 15, 16, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Publication No. 2001/0009017 ("Biliris") in view of Jones, U.S. Patent Publication No. 2001/0046069 ("Jones"). Independent claim 1 includes the limitations "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory" and "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company." With respect to claim 1, the Examiner acknowledged that Biliris fails to teach or suggest the above-quoted limitations of claim 1, but stated that: "Jones teaches determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory (para.[0003], [0018]), and adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company. (para.[0017])." (Final Office Action at para. no. 4, page 8). Each of the three paragraphs in Jones that were cited by the Examiner are addressed below.

Jones at paragraph no. 0003 is a background paragraph that discusses "confidential" or "proprietary" documents, and discloses that "[i]t is relatively difficult and unusual for someone to inadvertently manually send such a document to an unauthorized receiver. However, the use of Internet communication changes the situation." Jones at paragraph no. 0003 does not teach or suggest "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory", as recited in independent claim 1.

Jones at paragraph no. 0018 describes the email system shown in Figure 3, which includes a watermark detection and reading program 305. Jones at paragraph no. 0018 discloses that the program 305 determines if a message contains a watermark, and if the message contains a watermark, the program 305 determines whether the flag bit of the watermark is set to "confidential", and if the flag bit is set to "confidential", the message is returned to the sender. Jones at paragraph no. 0018 does not teach or suggest "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory", as recited in independent claim 1.

Jones at paragraph no. 0017 describes the data fields and flags used in a digital watermark. Jones discloses that the digital watermark is encoded into a background image by varying the width of lines contained in the background image. (See, e.g., Jones at para. no. 0016). The digital watermark disclosed in Jones is configured to be read by the watermark detection and reading program 305 (Jones at para. no. 0016), and does not appear to even provide any human readable information. Jones at paragraph no. 0017 does not teach or suggest "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1.

Thus, the paragraphs of Jones that were cited by the Examiner do not teach or suggest the above-quoted limitations of independent claim 1. Jones also discloses that a document may be stamped with the visible text "confidential". (See, e.g., Jones at para. no. 0016). Jones discloses that such a marking indicates that the document contains confidential information. (Jones at para. no. 0003). Thus, the "confidential" marking is based on the content of the document (i.e., based on whether the document contains confidential information), as opposed to being based on destinations specified in a given communication. There is no teaching or suggestion in Jones to add a "confidential" marking to a given email if it is determined that all destinations in the email are internal to a company. The "confidential" marking does not indicate to recipients whether a network communication is directed only to destinations internal to a company. Jones does not teach or suggest "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1.

In view of the above, independent claim 1 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 1 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 3, 4, 7, 9, and 12 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 3, 4, 7, 9, and 12 under 35 U.S.C. §103(a), and requests allowance of these claims.

Independent claim 15 includes the limitation "a controller configured to perform a search of the directory server based on the received destination information, determine whether the destination information specifies a destination that is internal to a first company based on the search, and add an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the first company." The Examiner stated that "claim 15 is rejected for the reasons set forth for claim 1." (Final Office Action at para. no. 4, page 12). For the reasons set forth above with respect to independent claim 1, Biliris and Jones do not teach or suggest the above-quoted limitations of independent claim 15.

In addition, claim 15 is directed to a single "network device". The Examiner is relying on the disclosure in Jones related to multiple network devices, including user terminals 301 and email server 302. However, there is no teaching or suggestion in Jones that any of the user terminals 301 includes a controller configured to perform a search of the directory server based on the received destination information, determine whether the destination information specifies a destination that is internal to a first company based on the search, and add an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the first company. There is also no teaching or suggestion in Jones that the email server 302 includes a controller configured to perform a search of the directory server based on the received destination information, determine whether the destination information specifies a destination that is internal to a first company based on the search, and add an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the first company. The Examiner appeared to argue that the digital watermark disclosed in Jones is an identifier that is added to a network communication to indicate to recipients whether the network communication is directed only to destinations internal to a company. In addition to the digital watermark not even being in a human-readable form, it is also important to note that there is no teaching or suggestion in Jones that the email server 302 is configured to add a digital watermark to a received communication. Rather, the email server 302 simply determines if a communication contains a digital watermark, and if it does, the email server 302 processes the digital watermark. (See, e.g., Jones at para. no. 0018).

In view of the above, independent claim 15 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 15 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claim 16 further defines patentably distinct claim 15, is further distinguishable over the cited references, and is believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claim 16 under 35 U.S.C. §103(a), and requests allowance of this claim.

Independent claim 18 includes the limitations "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory" and "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company." The Examiner stated that "claim 18 is rejected for the reasons set forth for claim 1." (Final Office Action at para. no. 4, page 12). For the reasons set forth above with respect to independent claim 1, Biliris and Jones do not teach or suggest the above-quoted limitations of independent claim 18.

In view of the above, independent claim 18 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 18 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 20 and 21 further define patentably distinct claim 18, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 20 and 21 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claims 5, 6, and 14 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 1 above, and further in view of Joseph et al., U.S. Patent No. 5,761,415 ("Joseph"). Dependent claims 5, 6, and 14 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 5, 6, and 14 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Arnold, U.S. Patent No. 6,275,848 ("Arnold"). Dependent claims 10 and 11 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 10 and 11 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw"). Dependent claim 13 further defines patentably distinct claim 1, is further distinguishable over the cited references, and is believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claim 13 under 35 U.S.C. §103(a), and requests allowance of this claim.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 3-7, 9-16, 18, 20, and 21 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 3-7, 9-16, 18, 20, and 21 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Response should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Jeff A. Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via facsimile to Facsimile No. (571) 273-8300 on this 21st day of **February**, 2006.

By:
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